

## **REMARKS**

### **Status of case**

Claims 1-16 are currently pending in this case. Claim 1 is an independent claim.

### **Claim Rejections under 35 U.S.C. § 112**

Claims 2 and 9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Specifically, the Office Action stated the following:

The claims are contradicting that e-mail should be sent even if it contains filtered keywords. For the purposes of examination, examiner best understood interprets both claims as allowing the e-mail to be sent to the recipient addressee within the time period if keywords are not present in the message. Clarification is required to determine what applicant is attempting to achieve.

Applicants respectfully contend that claims 2 and 9, as currently written, do not contradict one another. As an initial matter, claims 2 and 9 are not dependent on one another. Therefore, the claims may claim different aspects of the invention. For example, claim 2 recites that “the delivery means delivers the received email to the determined email recipientaddressee while the current time obtained by the clock means is within the trial period, if the determination result is ‘not deliver’.” As discussed in more detail below, during the trial period, the e-mail may still be delivered even if determination result is “not deliver.” This allows the recipient of the e-mail to determine during the trial period whether or not the screening data is too restrictive. Therefore, Applicants believe that claims 2 and 9 merely claim different aspects and do not contradict one another.

### **Claim Rejections under 35 U.S.C. §§ 102 and 103**

Claims 1, 3-10, and 13 were rejected under 35 U.S.C. § 102(e) as being anticipated by EP 1085436 (Nitta). Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nitta in view of U.S. Patent No. 6,654,787 (Aronson et al.). Claims 11 and 12 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over

Nitta in view of Aronson and in further view of U.S. Patent Application No. 6,199,103 (Sakaguchi).

The Nitta reference discloses an email server that filters emails on the basis of transmission conditions set by a client. See abstract. As acknowledged by the Office Action, the Nitta reference fails to teach or suggest setting a trial period for the email address. Instead, the Office Action relies on the Aronson reference for teaching this feature. Applicants respectfully contend that the Aronson reference fails to teach the limitations as currently recited in claim 1.

In Aronson, a “period” is an effective period set for each filtering rule. If the “period” expires, the filtering rule associated with the “period” becomes invalid. See col. 6, lines 30-43. Accordingly, in the Aronson reference, a specific process relating to the “period” is as follows:

- if the receipt time of the email is within the effective period and a keyword for filtering is included in the email, the email is blocked.
- if the receipt time of the email is within the effective period and a keyword for filtering is not included in the email, the email is transferred to the user.
- if the receipt time of the email is after expiration of the effective period, the filtering rule is not even executed and the email is transferred to the user.

As is evident, the Aronson reference teaches that the filtering of emails is not performed after the effective period. In contrast, claim 1 differentiates over Aronson in at least two respects. First, claim 1 recites that even during the trial period, the determining means determines whether to deliver the email. See claim 1 (“a third determining means for determining whether to deliver the email to the recipientaddressee based on the read screening data”). Second, claim 1 recites that during the trial period, the addressee is informed of the outcome of the determining means (whether or not the mail would have been delivered). See claim 1 (“if the time of receipt of the email is within the trial period and if the determination result is “not deliver”, a second reporting means for reporting information indicating that the addressee is within the trial period and indicating that if this email were received outside of the trial period, it would not be delivered” and “if the time of receipt of the email is within the trial period and if the determination result is “deliver”, a third reporting means for reporting information indicating that the addressee

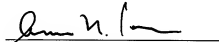
is within the trial period and indicating that if this email were received outside of the trial period, it would be delivered”).

Using this trial period in which the determination is made (but not carried out) and in which the user is informed of the determination is very advantageous. Specifically, the trial period allows the user to refine the screening data by which the determination is made without potentially deleting emails. For example, the user may determine whether too few or too many emails would be screened based on the determination information transmitted to the user (e.g., which emails would or would not have been transmitted) and based on the actual content of those emails. Thus, unlike the Aronson reference, the user may then modify the screening data during the trial period without running the risk that the screening data is too restrictive (thereby potentially deleting too many emails). Therefore, the claims as currently presented are patentable over the cited art.

#### SUMMARY

If any questions arise or issues remain, the Examiner is invited to contact the undersigned at the number listed below in order to expedite disposition of this application.

Respectfully submitted,



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